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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,244	12/21/2001	Nobuo Oi	2185-0602P	3414

2292 7590 07/15/2004

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EXAMINER
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RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/024,244

Applicant(s)

OI ET AL.

Examiner

Roberto Rábago

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-13, 16 and 19 is/are rejected.
- 7) ☒ Claim(s) 15, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Prior objections to claims 14 and 16, as well as rejection of claim 17 under 35 USC 112(2) are withdrawn in view of amendment.

#### *Claim Objections*

2. Claims 15 and 17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 15 and 17 use the additional phrasing "consisting of", yet the parent claims have already limited the copolymer to the two stated components by stating that the total amounts of vinyl compound (I) and straight-chain  $\alpha$ -olefin having 3 to 20 carbon atoms in the copolymer are 100 mol%. A sum total of 100 mol% for the two stated components precludes any additional components in the copolymer, and therefore the phrase "consisting of" as recited in the dependent claims adds no further limitation.

Applicant's arguments filed 4/16/2004 have been fully considered but they are not persuasive. Since the parent claims recite that the sum of the olefin and the vinyl compound (I) is 100 mol%, it means that there are no other monomers in the copolymer. Applicants' argument appears to be confusing the distinction between the copolymer component recited in claims 6 and 10 and the overall adhesive or laminate of claims 6 and 10. While the adhesive or laminate may include other components

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besides the copolymer, the copolymer itself is limited to those components which are expressly stated to add up to 100 mol% of its composition, and is therefore not open to include other components.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of claim 19 recites a random copolymer, yet the parent claim is drawn to an adhesive, and therefore the intended scope cannot be determined.

***Claim Rejections - 35 USC § 102 and 103***

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujii et al. (US 4,311,810) for the reasons set forth in item 5 of the Office action mailed 11/17/2003.

***Claim Rejections - 35 USC § 103***

6. Claims 4, 5, 10-13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (US 4,311,810) for the reasons set forth in item 6 of the Office action mailed 11/17/2003.

***Response to Arguments***

7. Applicant's arguments filed 4/16/2004 have been fully considered but they are not persuasive. Applicants' argument is not accepted because it fundamentally misinterprets the cited reference example. Contrary to applicants' argument, reference example A10 is not a block copolymer, but is expressly stated to be a random copolymer. The block copolymers to which applicants' appear to be referring are described in the "B" set of examples beginning at col. 21. However, as the "B" examples have not been applied against the claims, applicants' arguments are not relevant to the instant rejection.

Applicants' observation that the reference has disclosed vinylcyclohexene rather than vinylcyclohexane at col. 5, lines 17-18 is correct; however, this typographical error in the original rejection makes no difference in the propriety thereof because the use of vinylcyclohexane was not separately claimed, and the species vinylcyclohexene is equally effective for its suggestion to use a monomer within the scope of (I) which has cyclic structure.

***Allowable Subject Matter***

8. Claims 6-9 and 14 are allowed. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

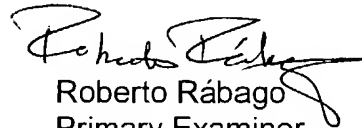
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:30 am - 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Roberto Rábago  
Primary Examiner  
Art Unit 1713

RR  
July 9, 2004